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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LIM3

PETITION ←
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on **MAY 2, 2007**Signature Typed or printed name **RISTO A. RINNE, JR.**

Application Number

10/826,830

Filed

April 16, 2004

First Named Inventor

EDMOND HENG LIM

Art Unit

3632

Examiner

WUJCIAK, ALFRED J.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number

37,055☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

RISTO A. RINNE, JR.

Typed or printed name

415.457.6933

Telephone number

MAY 2, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of **2** forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES DEPARTMENT OF COMMERCE
BEFORE THE PATENT AND TRADEMARK OFFICE

In re application of: Lim, Edmond Heng)
Serial No: 10/826,830) Group No.:3632
Filed: 04/16/2004) Examiner: Wujciak, Alfred J
For: Paper Plate Beverage Holder)

Commissioner of Patents and Trademarks

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop PETITION, Commissioner for Patents, Alexandria, VA 22313-1450 on May 2, 2007.

Risto A. Rinne, Jr.
(Name of person mailing paper)

Date: May 2, 2007


(Signature of person mailing paper) Reg. 37,055

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Hon. Commissioner of Patents and Trademarks

Sir:

In response to the Office Action mailed March 8, 2007, please consider the following in appeal of the dismissal decision and the basis thereof:

The petition to review the above-identified application was dismissed because the reply, it is asserted, was not an amendment that prima facie places the application in condition for allowance.

It is respectfully suggested that the corrected reply that was submitted with the petition to revive on July 11th, 2006 was not either the reply that was considered in making a determination regarding the petition to revive and that a determination of the

completeness of the reply that was filed with the petition to revive was improperly made because it raised new grounds that the applicant was previously not made aware of and therefore could not have possibly corrected.

This belief is based, in part, on the fact that certain of the reasons cited in the dismissal of the petition to revive are identical to those that were cited in a Notice of Non-Compliant Amendment that was mailed on April 3, 2006 with the exception of the comments appertaining to claim 21. Claim 21 is discussed hereinbelow. However, these defects had been corrected in the reply that was filed on July 11, 2006. The Notice of Non-Compliant Amendment was the Office's response to an "Amendment After Final" that was mailed on 12-23-2006. The defects in the Amendment After Final that was mailed on 12-23-2006 were corrected in the reply (i.e., a "Corrected Amendment After Final") that was submitted on July 11th, 2006 along with the petition to revive and therefore cannot possibly be proper basis for the dismissal of the petition to revive.

As relevant background information, a death in the immediate family on April 30, 2006 (a copy of the death certificate for Manuel Petrakis, father of my wife Stella Petrakis-Rinne, is enclosed) and the effects thereof resulted in a delay in the mailing of the response (i.e., the reply) to the Notice of Non-Compliant Amendment.

This delay occurred because I am a solo practitioner and because his death had significant impact on the surviving family. Consequently, the response to the notice of Non-Compliant Amendment was made at the first available opportunity, and was mailed on July 11, 2006. This response included a "Corrected Amendment After Final", a one-page letter of transmittal, a petition for revival of an application for patent abandoned unintentionally, and the required fee of \$750.00.

Specifically, the continuation of 4(e) that was provided with the dismissal states, "Other: Claims 11-12, and 14, "(previously amended)" should be changed to --(previously presented)-- and claim 21, "(re-presented)" should be changed to -(previously presented)-- for clarification." These are believed to have been corrected in the corrected amendment after final that was mailed along with the petition to revive on July 11, 2006. Therefore, this cannot be proper basis for dismissal if they were in fact corrected by the reply that accompanied the petition. At the very least it provides confusion and makes a proper response at this time by the applicant impossible to accomplish.

An additional reason was also cited in the dismissal sent March 8, 2007 regarding claim 21 that asserted that applicant failed to show marked up changes for claim 21 when it changed from a method claim to an apparatus claim using underline, bracket, or

striketthrough. This is believed to also be an incorrect basis for the dismissal. This is because the Office Action that was mailed on April 30, 2006 (i.e., The Notice of Non-Compliant Amendment) failed to make mention that any changes to claim 21 were required or were a basis of non-compliance. Accordingly, the applicant would certainly well-believe that the only required changes necessary to bring the Amendment After Final into condition of allowance were those that were specified in the notice of non-compliant amendment; specifically the changes to the claim identifiers.

Accordingly, the reply that was submitted on July 11, 2006 along with the petition for revival can only rightly be evaluated for compliance based on the content of the notice of non-compliant amendment that was mailed on April 30, 2007. It is improper to add new grounds at this time and then penalize the applicant for not having foresight to somehow anticipate and correct them. The applicant had no notice whatsoever provided by the USPTO to include marked up changes for claim 21 or that such changes to claim 21 were required to bring the Amendment After Final into compliance. This request was not part of the original requirement to bring the amendment after final into compliance. Therefore, it could not possibly be included as part of the reply that was a bona fide effort to correct the defects that were cited in the Notice of Non-Compliant Amendment.

Upon the Examiner's later (subsequent) review and determination that further changes to claim 21 were required to the Amendment After Final, these changes should have been communicated to the applicant by way of a second Notice of Non-Compliant Amendment. In other words, it is respectfully suggested and requested that the petition for revival should have been allowed as proper and that a subsequent office action should be mailed to the applicant regarding the newly found grounds of non-compliance for claim 21. Otherwise, the applicant is being penalized for making a bona fide effort complying with all of the stated requirements of an Office Action (i.e., the notice of non-compliant amendment) and subsequent to his compliance, not being granted a resumption of the normal course of prosecution.

Please grant the petition to revive the application.

Respectfully submitted:

A handwritten signature in black ink, appearing to read 'Risto A. Rinne, Jr.', with a stylized, cursive script.

Risto A. Rinne, Jr.

Reg. No. 37,055

2173 East Francisco Blvd. Suite E

San Rafael, CA 94901

Telephone 415 457-6933

STATE OF CALIFORNIA

CERTIFICATION OF VITAL RECORD

CITY AND COUNTY OF SAN FRANCISCO

CERTIFICATE OF DEATH

3200638002056

STATE FILE NUMBER		LOCAL REGISTRATION NUMBER	
1. NAME OF DECEDENT - FIRST (Given)		3. LAST (Family)	
MANUEL		PETRAKIS	
2. MIDDLE		M.	
4. DATE OF BIRTH		5. AGE Yr.	
10/18/1913		92	
6. BIRTH STATE/FOREIGN COUNTRY		7. DATE OF DEATH	
Greece		04/30/2006	
8. SOCIAL SECURITY NUMBER		9. HOUR (24 Hours)	
353-18-6408		0200	
10. EVER IN U.S. ARMED FORCES?		11. MARITAL STATUS (at Time of Death)	
<input checked="" type="checkbox"/> YES <input type="checkbox"/> NO <input type="checkbox"/> UNK		Married	
12. DECEASED'S RACE - (List in 3 places if related (see worksheet on back))		13. DECEASED'S SEX	
White		Male	
14. DECEASED'S OCCUPATION (Type of work for most of life. DO NOT USE RETIRED)		15. YEARS IN OCCUPATION	
Entomologist		55	
16. DECEASED'S RESIDENCE (Street and number or location)			
2200 Sacramento Street, #1503			
17. CITY		18. STATE/FOREIGN COUNTRY	
San Francisco		California	
19. INFORMANT'S NAME, RELATIONSHIP			
Carmencita Petrakis - Wife			
20. INFORMANT'S MAILING ADDRESS (Street and number or rural route number, city or town, state, ZIP)			
2200 Sacramento Street, #1503, San Francisco, CA 94115			
21. NAME OF SURVIVING SPOUSE - FIRST		22. LAST (maiden name)	
Carmencita		Diaz	
23. NAME OF FATHER - FIRST		24. LAST	
Mark		Petrakis	
25. NAME OF MOTHER - FIRST		26. LAST (maiden)	
Stella		Christoulakis	
27. DATE OF DEATH		28. PLACE OF DEATH	
05/08/2006		RES of Carmencita Petrakis, 2200 Sacramento Street, #1503, San Francisco, CA 94115	
29. TYPE OF DISPOSITION		30. LICENSE NUMBER	
CR/RES		6947	
31. NAME OF FUNERAL ESTABLISHMENT		32. SIGNATURE OF LOCAL REGISTRAR	
HALSTED N. GRAY - CAREW & ENGLISH		FD334	
33. DATE OF DEATH		34. DATE OF REGISTRATION	
05/03/2006		05/03/2006	
35. PLACE OF DEATH		36. CITY	
The Sequoia's		San Francisco	
37. CAUSE OF DEATH		38. DEATH REPORTED TO CORONER?	
Cardiopulmonary Arrest		<input checked="" type="checkbox"/> YES <input type="checkbox"/> NO	
39. CONGESTIVE HEART FAILURE		40. DEATH REPORTED TO CORONER?	
Congestive Heart Failure		<input checked="" type="checkbox"/> YES <input type="checkbox"/> NO	
41. ISCHEMIC HEART DISEASE		42. DEATH REPORTED TO CORONER?	
Ischemic Heart Disease		<input checked="" type="checkbox"/> YES <input type="checkbox"/> NO	
43. OTHER SIGNIFICANT CONDITIONS CONTRIBUTING TO DEATH BUT NOT RESULTING IN THE UNDERLYING CAUSE GIVEN IN 101		44. DEATH REPORTED TO CORONER?	
Cerebrovascular Accident		<input checked="" type="checkbox"/> YES <input type="checkbox"/> NO	
45. WAS OPERATION PERFORMED FOR ANY CONDITION IN ITEM 101 OR 112? (If yes, list type of operation and date.)		46. IF FEMALE, PRESENT IN LAST YEAR?	
No		<input type="checkbox"/> YES <input checked="" type="checkbox"/> NO <input type="checkbox"/> UNK	
47. I CERTIFY THAT TO THE BEST OF MY KNOWLEDGE DEATH OCCURRED AT THE HOUR, DATE, AND PLACE STATED FROM THE CAUSE STATED		48. SIGNATURE AND TITLE OF CERTIFIER	
49. DATE OF DEATH		50. DATE OF REGISTRATION	
03/17/2005		04/29/2006	
51. TYPE ATTENDING PHYSICIAN'S NAME, MAILING ADDRESS, ZIP CODE		52. LICENSE NUMBER	
Jean K. Haddad, MD, 909 Hyde Street, San Francisco, CA 94109		G7965	
53. I CERTIFY THAT IN MY OPINION DEATH OCCURRED AT THE HOUR, DATE, AND PLACE STATED FROM THE CAUSE STATED		54. DATE OF DEATH	
55. MANNER OF DEATH		56. DATE OF REGISTRATION	
Natural <input type="checkbox"/> Accidental <input type="checkbox"/> Homicide <input type="checkbox"/> Suicide <input type="checkbox"/> Pending Investigation <input type="checkbox"/> Could not be determined <input type="checkbox"/> YES <input type="checkbox"/> NO <input type="checkbox"/> UNK		05/02/2006	
57. PLACE OF INJURY (e.g., home, construction site, address street, etc.)		58. INJURY DATE	
59. DESCRIBE HOW INJURY OCCURRED (e.g., vehicle struck, resulted in injury)		59. INJURY DATE	
60. LOCATION OF INJURY (Street and number, or location, and city, and ZIP)		60. INJURY DATE	
61. SIGNATURE OF CORONER / DEPUTY CORONER		62. DATE	
63. TYPE NAME, TITLE OF CORONER / DEPUTY CORONER		63. TYPE NAME, TITLE OF CORONER / DEPUTY CORONER	
64. STATE REGISTRAR		64. STATE REGISTRAR	
65. FAX AUTH.		65. FAX AUTH.	
66. CENSUS TRACT		66. CENSUS TRACT	

STATE OF CALIFORNIA, CITY AND COUNTY OF SAN FRANCISCO
This is to certify that the image reproduced hereupon is a true copy of the record on file in the SAN FRANCISCO DEPARTMENT OF PUBLIC HEALTH as of the date issued

DATE ISSUED

MAY 08 2006

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